

# Unravelling the Future and Scope of Smell Marks Under the Trademarks Act, 1999

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## ABSTRACT

The realm of intellectual property law is evolving amidst the traditional notions of visual trademarks and the development of an olfactory revolution is underway. To attain this objective, the top-notch companies develop unique logos, labels so on and so forth to catch the eye of every ultimate consumer they target upon<sup>1</sup>. Recently, as the industries strive towards engaging the consumers through multisensory experiences, the recognition and protection of non-conventional trademarks specifically scents gain prominence. This article focuses on the future and scope of smell marks in Indian trademark law by comparing the existing laws of United States of America, and European Union. The article begins by throwing lights on the current status of smell marks in the Indian Trademarks Act. A critical analysis and comprehensive overview of the Act in examining existing provisions and challenges associated with registering and protecting olfactory trademarks, considering the subjectivity and fluidity of scent perception is been done. In order to be served as a benchmark for evaluating the adequacy of existing frameworks within the Indian context, drawing parallels with international practices is necessary. The approaches adopted by other jurisdictions, such as the European Union and the United States in recognizing and safeguarding smell marks has been observed. Furthermore, considering the growing significance of scent branding and the global trend towards acknowledging the distinctiveness of olfactory identifiers, the article strives to anticipated the future trajectory of smell marks in India. The article emphasis on the need for amendments required in the current legal frameworks to accommodate and protect smell marks balancing with the interests of trademark owners and consumer. The article underscores the importance of a proactive legal framework that not only protects the rights of the trademark owners but also ensures a fair and transparent system for adjudicating olfactory trademarks.

**KEYWORDS:** Trademark, Smellmarks, Olfactory Marks, Nonconventional Trade Marks, Digitalisation, Graphical Representation

## INTRODUCTION

Trademarks have traditionally been associated with visual symbols, logos or words which are unique symbols used by any entities in order to protect the business of these entities. However, with the rapid growth of industries, sensory experience has become integral to brand identity. Within the purview of trademarks law, “smell marks” has emerged as a fascinating area. Trade Mark is a combination of two

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<sup>1</sup> **Bluebook 21st ed.** Prerna Wahni, Comparative Analysis of Sound and Smell Trademark, 3 JUS CORPUS L.J. 1089 (2022)

words “trade” and “mark” which basically distinguishes the goods or services of two different persons.<sup>2</sup> The legal framework has continually evolved to accommodate emerging varieties of branding forms by inculcating non- traditional marks like sounds, combination of colour, shape. Traditionally the intention of trademark law was not to protect consumers.<sup>3</sup> Unconventional marks such as motion marks, sound marks, shape marks, gesture marks and texture marks are being accepted and registered as trademarks in various jurisdictions. However, non-visual marks still face challenges in the process of trademark registration.<sup>4</sup> This paper focuses on Indian Trademarks Act and the need for inclusion of smell marks as a non- conventional mark. The evolution of smell marks in other jurisdictions such as United States of America and the European Union is analysed and issues about registration of smell marks in India has been highlighted. Various suggestions and recommendations with regard to the need to widen the scope for smell marks in India is discussed as well.

### **SMELL MARKS**

The smell is a sense that can trigger and have an impact on the memory, mood and mind of a consumer.<sup>4</sup> It can be recognised through the natural sense of a human being. Smell marks or olfactory marks or scent marks plays a vital role in helping customers distinguish products available in the market.<sup>5</sup> As per the report of Standing committee on the Law of Trademarks conducted in 2006 by the WIPO, only 20 out of 70 trademark offices accepted smell marks.<sup>6</sup> However all smell cannot be qualified for registration under trademarks. The smell should be distinctive in nature and the customers should be able to connect smell and the product Unlike ancient times, the producers invest more in branding so that they create a concept of differentiation of products by the consumers.<sup>8</sup> This has made them more creative and thereby increases the scope of olfactory marks.

### **CONCEPT OF NON- CONVENTIONAL TRADEMARK**

Non- conventional trademarks are those marks which are not traditional trademarks by its very nature. A non- conventional trademark can also be eligible for registration if it satisfies the requirements as per the Act. The Act requires mark to be capable of being graphically represented to be registered as a trademark. Concept of non-traditional trademarks has been recognised recently both nationally and internationally. The registrability of smell marks or olfactory marks is not gained much attention in major international or national laws as it is practically difficult. Trademark law Treaty, 1994 expressly excluded the registration of smell marks. However, TRIPS took a neutral stand in this regard. This is why we should discuss national laws with regard to the smell marks.

### **UNITED STATES OF AMERICA ON SMELL MARKS**

In U.S. the scope of trademark was stretched with the enactment of the Lanham Act.<sup>7</sup> It left the Courts wi-

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<sup>2</sup> Anil Babu Shete, Introduction to Trademarks, 2 LAW ESSENTIALS J. 236 (2021).

<sup>3</sup> Mark P. McKenna, The Normative Foundations of Trademark Law, 82 NOTRE DAME L. REV. 1839 (2007). <sup>4</sup> Akanksha Choudhary & Ashna Shah, Position of Smell Marks and Taste Marks: India vs Developed Nations, 5 INT'L J.L. MGMT. & HUMAN. 2087 (2022).

<sup>4</sup> Rachel S Herz and Trygg Engen, Odor Memory: Review and Analysis, 3 PSYCH. BULL. & R. 300, 300 (1996)

<sup>5</sup> James E. Hawes, Fragrances as Trademarks, 79 TMR 134, 135, (1989).

<sup>6</sup> WIPO, Report of Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications, Geneva 16 (2006).

<sup>7</sup> Lanham Act, 15 U.S.C. §§ 1051-1142 (2006)

th questions as to the registration of non- conventional marks under the Act. The topic of scent marks was first addressed by the Trademark Trial and Appeal Board (TTAB), an adjudicatory body within the United States Patent and Trademark Office in **IN RE CELIA CLARKE**.<sup>8</sup> In this case, a woman named Celia Clarke sold scented yarn. Clarke's application was made to USPTO describing the scent with a written description.<sup>9</sup> However, the application was rejected by the examining attorney on the ground that the "Indication of origin" would not be recognised by the consumers. The Major issue was whether the mark is distinctive in nature. The Trademark Trial and Appeal Board overturned the Examining authority's decision and ruled on favour of Clarke and held that she has adequately shown the secondary meaning of her scent mark and her product is unique as well. It was observed that the smell of the yarn is capable of distinguishing the product from any other product and recognised that the only manufacturer who had smell mark was the applicant who can easily get into the minds of the consumers. Henceforth, Clarke became the first case to accept scent mark in the history of United States of America. The court came to the conclusion to grant smell marks as it demonstrated the distinctiveness of her fragrance mark and also on the basis of functionality aspect. The guidelines in US for registration of non-traditional trademarks was altered post Clarke decision.<sup>10</sup> The Trademark Manual of Examination Procedures requires the functionality test to be complied before being registered. It emphasizes on a description in writing of the scent mark rather than a drawing. It can be seen that Lanham Act rather makes non- conventional marks more flexible in nature than subjective. In U.S the applicants are required to mail the scented goods to the USPTO instead of submitting it electronically. This makes it possible for representation before the USPTO. They are required to submit information as to the specimen with proper description online and then mail the physical specimen so that it matches the description.<sup>11</sup> In U.S.A. the Lanham Act,1946 provides for registration of olfactory marks effectively under section2(f) on two factors: non-functionality; distinctive features.

## EUROPEAN UNION ON SMELL MARKS

European Union had undergone two major changes with respect to trademarks before 2008. The implementation of the Harmonization Directive in 1989<sup>12</sup> and adaptation of the Community Trade Mark Regulation in 1993. In 2009 the council Regulation (EC) No. 201/2009 made reform on CTMR. The landmark judgment in *Ralf Sieckmann v Deutsches Patent- und Markenamt*.<sup>13</sup> The chief issue highlighted by ECJ in the instant case was whether a mark that is represented with a description "balsamically fruity scent with a slight hint of cinnamon" could be registered as a trademark. This case was an attempt of Mr. Sieckmann in registering a scent. In order to satisfy the graphical representation, he provided the chemical formula along with a sample of scent. The visual perceivability of a trade mark in order to grant trademark was questioned and the court refused to grant trade mark for those marks that is not capable of being

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<sup>8</sup> IN RE CELIA CLARKE, DBA CLARKE'S OSEWEZ Serial No 758,429 September 19, 1990, <https://ipmall.law.unh.edu/content/ttab-trademark-trial-and-appeal-board-1-recelia-clarke-dba-clarkes-osewezserial-no-758429>.

<sup>9</sup> "a high impact, fresh, floral fragrance reminiscent of [plumeria blossoms]."

<sup>10</sup> U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (8th ed. 2011), available at <http://tess2.uspto.gov/tmdb/tmep>.

<sup>11</sup> Trademark Manual Of Examining Procedure §904.03(m).

<sup>12</sup> Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to Trade Marks, recitation 9, 1989 O.J. (L 40/1).

<sup>13</sup> Case C-273/00 Sieckmann v Deutsches patent- und Markenamt [2003] Ch 487, [2003] 3 WVLr 424

Perceived visually<sup>16</sup>. These criteria are called as sieckmann seven.<sup>17</sup> Hence the requisite of graphical representation operates as a hurdle for all those non-conventional trademarks like scents and sounds practically beyond being a badge of origin.<sup>14</sup> The court in this case emphasises on the “easily accessible” criteria on a common man. A common man may not be able to recognise a chemical formula of a scent unless and until he has smelt it before.<sup>15</sup> This reasoning favours traditional marks since non-conventional marks like music or scent cannot be recognised by a common man by merely looking into the musical notes or chemical formula. The Office of Harmonization in the Internal Market (OHIM) in 2001, revisited the meaning of “graphical representation” with respect to raspberry scent applied in engine fuels.<sup>16</sup> Though the registration was initially refused on graphical representation ground, the OHIM decided that “the smell of raspberries” and “the smell of freshly cut grass<sup>17</sup>” can be protected under the CTM protection which is now known as EUTM Protection. The scent of raspberries unlike the scent of cinnamon is recognisable by the consumers as it is unique and has a pure smell of a fruit. Therefore, it is sufficient to represent it in words to send a clear message. In *Vennootschap onder Firma Senta Aromatic Marketing V Markgraaf B.V*<sup>18</sup> the registration of tennis balls as an olfactory mark with the smell of fresh cut grass was in question. The examiner denied the registration by virtue of Article 7 (1)(a) of Council Regulation (EC) No 49/94 of 20 December 1993 on the Community trade mark.<sup>19</sup> The rationale behind this decision was that the olfactory mark could not be represented graphically and the applied mark is mere description of the mark. The applicant points out that the graphical representation doesn’t mean a representation to be depicted in a particular shape. However, the examiner denied registration on the ground that mere description is not the graphical representation and the requirement of CTMR for a mark to be registered is to be capable of represented graphically. On appeal the major issue to be addressed was whether the trademark in the nature of a smell is sufficiently represented in graphical form as to satisfy the necessity as per Article 4 CTMR. The appellate court looked on the facts and reasoning of the case opined that the smell of freshly cut grass is distinct in nature which everyone could relate and recognise from experience. The Board held that the tennis ball should be granted trademark as it complies with the graphical representation under Article 4 CTMR.

In 2015 the EU legislative framework was revised by a new (amending) Regulation<sup>1</sup> and a new Trade Mark Directive. They aim to ensure that the system overall continues to remain effective in meeting the needs of business as technology develops, updating it rather than introducing fundamental changes. The Directive is required to be implemented into UK law by 14th January 2019. By virtue of this, trademarks no longer require to fulfil the requirement for graphical representation.<sup>20</sup> The sign should be presented in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.<sup>21</sup> This is a positive sign for non-unconventional

<sup>14</sup> M. M. S. Karki, "Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress" (2005) 10JIPR 499.

<sup>15</sup> Michael Goulboun, "Registration of Olfactory, Aural, and Three-Dimensional Trade Marks in the EU and UK: a Comparison" (2012) 7(11) JIPLP 816, 818.

<sup>16</sup> Court decision 5.12.2001, Myles Ltd. Application, (R 711/1999-3), OHIM Board of Appeal. Accessible: <http://www.copat.de/markenformen/wrp2002/wrp10.pdf>, 12th, December 2017.

<sup>17</sup> (OJ OHIM 10/99, p. 1239)

<sup>18</sup> *Vennootschap onder Firma Senta Aromatic Marketing V Markgraaf B.V*, R 156/(1998)-2

<sup>19</sup> OJ 1994 L 11, p.1

<sup>20</sup> Article 4(b) EUTMR, Article 3 (b)EU Trademark Directives.

<sup>21</sup> <https://www.jonesday.com/en/insights/2016/04/overview-of-european-trade-mark-law-reforms> <sup>39</sup> CJEU 24 June 2004, C-49/02, Heidelberg Bauchemie, EU:C:2004:384, para. 24.

trademarks as it opens gate for more scope of registering marks that cannot be graphically represented. The major objective behind this criterion of representation is “to prevent the abuse of trade mark law in order to obtain an unfair competitive advantage”<sup>39</sup>.

### **SMELL MARKS IN INDIA**

The Trade Marks Act, 1999 has shown a relatively slow growth of non-conventional marks when compared to other countries. The definition of trademark as in the Trademark Act needs to be analysed in this juncture. Section 2(1) (zb) of the Trademark Act, 1999 defines trademark. It specifically states that a mark should be trademark if it is capable of being graphically represented. This makes it difficult for olfactory trademark to be registered in India. Trademark rules 2002 Rule 28 and 30 acts as a significant impediment. Unlike the United States, India follows a stricter rule in representation of trademark. It is practically difficult to represent a smell in paper. This henceforth forms the major hurdle in accepting olfactory marks. The draft manual of trademarks requires the graphical representation of a mark to be durable and satisfactory.<sup>22</sup> There seems to have little or no movement in smell marks in India. However, The Draft Manual of Trademarks (2015) expressly identified smell marks as one of the unconventional marks but declared it does not fulfil the requirement as per the criteria of graphical representation. The Trademarks Rules, 2017 clearly missed out even to mention smell marks.<sup>45</sup> Unlike other countries, Indian law specifies graphical representation to be mandatory requirement for successful registration of trademark which limits the scope of olfactory marks.

### **GRAPHICAL REPRESENTATION:**

In India, by virtue of section 2(1) (zb) of the Act, a sign to be granted trademark protection must be capable of being graphically represented. In the *Swizzles Matlow Ltd's*<sup>23</sup>, the Court elucidated the primary justifications for the necessity of the graphical representation criterion. Firstly, for facilitating clear identification for traders from the same field; also, to ensure public identification of a product by its precision.

Under the Trade Marks Act, 1999, marks are required to be capable of graphically represented for being registered as a trade mark. Being non-visual element, it is extremely difficult task for a smell mark to be graphically represented. This stands as a barrier to register smell marks in India. Non-visual signs can be described properly with the use of proper wordings which is sufficient for identifying the mark. Removing this criterion will definitely open doors for inclusion of more non-conventional trademark registration. Indian Trade Mark Registry should identify alternate methods by which a mark can be represented. A written description of the smell can be an efficient form of representation for registration. A clear and precise description can give an exact picture of the subject matter seeking trademark protection. Further, along with the description, the applicants shall also provide a specimen of the smell. The applicant must have the responsibility to prove the durability, consistency, longevity of the same. It has been proved to be effective when the specimen is mailed along with the description as in USA. In *Libertel Groep BV V Benelux Trade Mark Office*<sup>51</sup> the Court looked into the issue whether a single colour be granted trademark. ECJ in this case reiterated the conditions laid down in *Sieckmann* case as to graphical representation. It requires a mark to be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

<sup>22</sup> Draft Manual of trademarks, Chapter III, 3.2.4 at page no. 82. <sup>45</sup> The Trademarks Rules, 2017 (India).

<sup>23</sup> *Swizzles Matlow Ltd.'s Application* (No 2), (2000) ETMR 58.



The instant case was with relation to granting colour mark to a flat surface with a description in words with the help of internationally recognised code of the colour like pantone. Court observed that it may constitute a graphic representation as it is deemed to be precise and stable. ECJ's ruling in this case is a practical solution towards the matter by using pantone colour system. The Pantone colour system is a commercial system that designates specific colour shades numerically and thereby it can categorize colours by unique codes.<sup>24</sup> Graphical representation should not merely mean representation in paper rather new methods of identifying and classifying such marks should develop and be adopted by courts in granting protection to non- conventional trademark as well.

### **DIGITALIZATION TECHNOLOGY:**

Transferring smell online is an unpopular concept. With advance of science and technology, scent detection and smell categorisation has been improved. Digitalization or digital scent technology uses e-nose to detect scent. Digitalising smells can prevent degradation of smell by proper storage and easy virtual transmission.<sup>25</sup> In identifying smells, specialised technology like Chromatographic technology can be used. Chromatography is an important biophysical technique that separates and identifies components of a mixture.<sup>26</sup> Though these methods have undergone certain criticisms, the courts have used this technology to identify smell.<sup>27</sup> Digitalizing can help to a greater extent in making the smell marks registration more practical in identifying the smell in addition to the description as well as the specimen test. Digital scent technology is considered as a vital development as far as the smell marks are considered. It permits the transmission of scent or smell virtually over the internet. The iSmell Personal Scent Synthesizer developed by Digiscents Inc. It is a peripheral device that can read a digital scent file.<sup>28</sup> This methodology provides a reform in olfactory trademark regime though difficult to be executed. As per the definition under Rule 2(k) of the Trade Marks Rule, 2017 as mandated under Section 2(1) (zb) of the Trade Marks, Act 1999 representation of a trademark includes representation in the form of digitalisation. The term "graphical representation" should be evaluated in a more liberal and wider context so as to include non- conventional marks and not construed as in TRIPS, the requirement of "visual perceptibility".<sup>29</sup>

### **FUNCTIONALITY:**

The functionality aspect has attained more attention across globally under foreign jurisdiction with respect to registration of non- conventional marks. It is of utmost important for Indian Trademark Law to include the doctrine of functionality to prevent unfair practices and monopolies. In U.S.A. the functionality doctrine was applied in Re Clarke case. The U.S Trademark Review Commission in its review of the Trademark Act, 1946 observed that "symbol or device" such as a colour, shape, smell sound or

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<sup>24</sup> The United Parcel Service holds a registration for the colour chocolate brown, which is equivalent of the Pantone colour designated by the code 'PANTONE 462 C'. See Wilson Gerome & LaLonde Anne Gilson, Cinnamon buns, marching ducks, and cherry-scented racecar exhaust: Protecting non-traditional trademarks, <http://www.usebrinks.com/docs/publications/141.pdf> (16 March 2006).

<sup>25</sup> John T. Cross, Trademark Issues Relating to Digitalized Flavour, 19 YALE J. L. & TECH., 339, 340-343 (2017), <https://openyls.law.yale.edu/bitstream/handle/20.500.13051/7818/JohnTCrossTrademarkIssues.pdf>.

<sup>26</sup> <https://www.ncbi.nlm.nih.gov/pmc/articles/PMC5206469/>

<sup>27</sup> Chanel, Inc. v. Smith, 178 U.S.P.Q. 630 N.D.Cal. (1973)

<sup>28</sup> Sorna Mugi Viswanathan/ Revanth Rajan, Digital Scent Technology- A Critical Overview, International Journal of Trend in scientific Research and Development (ijtsrd), ISSN : 2456-6470, Vol-4, (2020) PP218-221; [www.ijtsrd.com/papers/ijtsrd30920.pdf](http://www.ijtsrd.com/papers/ijtsrd30920.pdf).

<sup>29</sup> Article 15 of TRIPS lays down that members may require as a condition of registration, that signs be visually perceptible.

configuration that functions as a mark should not be narrowed to preclude its registration as a mark.<sup>30</sup> In *Qualitex Co. v Jacobson Prods.co.*,<sup>31</sup> it was held that a mark should not be functional in nature and it should be source identifying. Trademark cannot be granted to any product whose inherent attribute is smell. In *NY. Pizzeria, Inc v. Syal*<sup>32</sup> it was held that “the functionality doctrine is a significant hurdle for any party seeking to protect a flavour as a trademark”.<sup>33</sup> In *re N V Organon*<sup>62</sup>, the Trademark Trial and Appeal Board observed that orange flavour of medicine cannot be granted trademark protection as it functions as to cover the appalling taste of the pill. A smell to be capable of being registered as a smell mark should not be functional by its very nature. Indian law should inculcate functionality requirement into its law as a characteristic to avoid any kinds of misuse.

### CONCLUSION AND ANALYSIS:

Non-conventional trademark including smell marks are considered as an import revolution that is adopted by certain traders to promote their products in a different manner. The basic purpose or objective of granting trademark is to prevent confusion in the minds of consumers in the midst of increasing competition and to bring healthy competition by making products unique. International treaties always had a neutral stand towards non-conventional marks. U.S.A has however shown a positive sign with regard to registering smell marks. EU Laws though showed green card, had made rigid path towards registering smell marks post *Ralf Sieckman Case*. In India, Section 9 and section 11 of the Trade Marks Act, 1999 lays down absolute and relative grounds of trademark. This requires a mark to be distinctive; it should not be generic in nature as well. The major hindrance is the descriptive nature of smell mark. It is difficult to register a mark that is descriptive. Further, the Indian law unlike U.S and EU, require graphical representation for a mark to be capable for registration. Indian trademark Act should be modified and widen the scope of graphical representation in order to include non- conventional marks that is incapable of being graphically represented. Technologies like digitalisation as we have already discussed can be effectively used to represent smell in a definite way by separating its chemicals definitely. Another effective way to make smell mark a practical concept is to look into the functionality aspect. The smell used as a mark should not be the basic purpose or function of that product but must be an identifier of the source of the product. The olfactory mark is something that has an effect of being in the minds of the consumers for a very long term. Therefore, Indian Trade Mark Act, 1999 requires an amendment by widening the meaning of graphical representation as well as inculcate functionality test and digitalisation in order to make smell marks registerable for the protection of creative marks. Therefore, it can be concluded that as of now, Indian law cannot accommodate smell marks unless and until it widens the scope of requirements of trademark registration.

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<sup>30</sup> Supra Note 18.

<sup>31</sup> *Qualitex Co. v Jacobson Prods. Co.*, 514 U.S. 159 (1995).

<sup>32</sup> Registration No. 5467089, USPTO.

<sup>33</sup> Akanksha Choudhary & Ashna Shah, Position of Smell Marks and Taste Marks: India vs Developed Nations, 5 INT'L J.L. MGMT. & HUMAN. 2087 (2022). <sup>62</sup> *N.V. Organon*, No. 76467774 (T.T.A.B. June 14, 2006)